

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HEINZ J. GERBER

Appeal No. 1999-2101
Application No. 08/929,012

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, COHEN and ABRAMS,
Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 15-21, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to an apparatus for bite cutting garments. An understanding of the invention can be derived from a reading of exemplary claim 15, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Gerber ('980)	4,091,980	May 30, 1978
Gerber ('820)	4,178,820	Dec. 18, 1979
Gerber ('572)	5,141,572	Aug. 25, 1992
Le Blond (UK Patent Application)	2 133 731	Aug. 1, 1984

Claims 15-21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 15-21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gerber '572 in view of Gerber '820, Le Blond and Gerber '980.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 27) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 26) and Reply Brief (Paper No. 28) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention is directed to an apparatus for segment-by-segment cutting of pattern pieces from fabric or the like, and includes means for generating a "continuous marker" based upon receiving data regarding the size and shape of each pattern piece. It is important to note at the outset that "continuous marker" has been defined in the specification to mean a marker that continuously defines pattern pieces comprising made to order garments or groups of garments as data defining such garments is received (page 3). As we understand this feature of the invention from the specification and the explanations offered in the Brief, it continuously defines and redefines the existing marker during the cutting operation as new data is received, that is, "on the fly," as opposed to the prior art systems, in which a marker is produced from a collection of data and, once produced, remains static during the cutting operation.

As manifested in independent claim 1, the appellant's invention comprises a computer-aided design system for continuously receiving data representing a plurality of made to order garments and for continuously generating a marker in response to the data

as it is received, the marker providing a set of machine readable marker instructions that defines the contour of the pieces, arranges them relative to one another as they are to be cut from one or more bites to optimize usage of the material, and “provides a specific length value for each bite of sheet material to avoid partial cutting of the individual pattern pieces on each bite of sheet material.” The claim further recites a carriage assembly for moving a cutting tool over a work table upon which the material is spread, the carriage assembly including a coupling mechanism for advancing successive bites of the material over the work surface, a vacuum source for holding the sheet against the surface, and a controller for converting the marker instructions into command signals to direct the carriage assembly to advance successive bites of material onto the work surface “in accordance with said specific length values” and to direct the movement of the carriage assembly and the cutting tool to cut the individual pattern pieces from the material.

The Rejection Under 35 U.S.C. § 112, Second Paragraph

The examiner has rejected claims 15-21 as being indefinite, citing four items in claims 15, 17, 19 and 20 as “some noted examples”¹ (Answer, pages 4 and 5). The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a

¹The use of the term “examples” would imply that there are other points of indefiniteness which are not described in the rejection. This, of course, would not be in accordance with the goal to “clearly articulate” the rejection that is set forth in Section 706 of the Manual of Patent Examining Procedure. We have considered the “examples” set forth by the examiner to be the full extent of the indefiniteness.

particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. From our perspective, considering the appellant's claims in this light leads us not to agree with the examiner with regard to any of the "examples" raised, for the reasons expressed by the appellant on pages 4-6 of the Brief. Suffice it to say, on our part, (1) that an applicant is free to express elements of the claim in language that includes the functions to be accomplished by the structure, and (2) a claim is not indefinite simply because it is broad.

This rejection is not sustained.

The Rejection Under 35 U.S.C. § 103

Independent claim 15 and dependent claims 16-21 stand rejected as being unpatentable over the teachings of Gerber '572 taken in view of those of Gerber '820, Le Blond and Gerber '980. With regard to independent claim 15, it is the examiner's view that Gerber '572 discloses the invention "substantially as claimed," and to the extent that the elements disclosed in the primary reference fail to "inherently" perform the functions recited in the claim, Gerber '820 teaches using a computer to arrange the pattern pieces in such a

fashion as to minimize the amount of material required, which "has a direct correlation to the 'size' of the material." As for the vacuum source for holding the material on the work surface and the means on the carriage for moving the material onto the work surface, the examiner points to Le Blond and Gerber '980, concluding from them that it would have been obvious to provide these features on the system of Gerber '572. See Answer, pages 6-8. The thrust of the appellant's arguments in rebuttal to the positions taken by the examiner is that all of the applied references disclose systems in which a marker instruction is generated by data received prior to the start of the cutting operation, which results in a static marker being generated, whereas the claim recites a system in which a marker is "continuously" generated in response to a stream of data, and the instructions include providing a "specific length value" for the sheet material to cause the carriage material coupling means to advance bites of material onto the table in response to this value to avoid partial cutting of parts of the pattern. See Brief, pages 6-11.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985).

To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

We agree with the appellant that Gerber '572 fails to disclose or teach a computer aided design system in which data is continuously received and a marker is continuously generated during the cutting operation, which marker includes the required "specific length value" that is then passed as an instruction to the carriage coupling mechanism so that bites of material are advanced of sufficient length as to insure that all of the pattern pieces can be cut therefrom. As we understand the Gerber '572 system, data is received and a marker is generated from that data, after which the pattern pieces are cut from a bite of material of predetermined length. The shortcomings of Gerber '572 with regard to the claimed subject matter are not alleviated by consideration of the teachings of the other four applied references, for all of them fall into the same category of machine, described by the appellant as generating "static" marker instructions which, once established, are not "continuously" generated. This being the case, the artisan would not have been instructed by the references to generate a marker that provides instructions to advance the material based upon the "continuous" receipt of data as determined by the "specific length values." It therefore is our conclusion that the

combined teachings of the five applied references fail to establish a prima facie case of obviousness with respect to the subject matter recited in independent claim 15, and we will not sustain the Section 103 rejection of claim 15 or, it follows, of dependent claims 16-21.

CONCLUSION

Neither rejection is sustained.

The decision of the examiner is reversed.

REVERSED

HARRISON E. McCANDLISH
Senior Administrative Patent Judge

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

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APPLICATION NO. 98/929,012

APJ ABRAMS

APJ McCANDLISH

APJ COHEN

DECISION: **REVERSED**

Prepared By:

DRAFT TYPED: 18 Jan 02

FINAL TYPED: